UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/162,212	06/05/2002	Xin Wang	111325-230300	3700

22204 7590 12/16/2009

NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER	
AUGUSTIN, EVENS J	
ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
12/16/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte XIN WANG and BIJAN TADAYON

Appeal 2009-008480
Application 10/162,212
Technology Center 3600

Decided: December 16, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Xin Wang and Bijan Tadayon (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-19 and 29-40. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.[1]

THE INVENTION

The invention "relates to a method and system for digital rights management and, more particularly, to a method and system for automatically offering and granting rights over a communications network or other channels." Specification [0003].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. A method for transferring usage rights adapted to be associated with items within a digital rights management system, said method comprising:
>
> generating, by a supplier, at least one first offer including usage rights and meta-rights for the items, said usage rights defining a manner of use for the items, said meta-rights specifying rights to derive usage rights or other meta-rights for the items;
>
> presenting, by the supplier, said offer to a first consumer in said system,

[1] Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed Jul. 7, 2006) and the Examiner's Answer ("Answer," mailed Feb. 13, 2007).

wherein the offer expresses what rights the consumer can acquire for the items;

receiving, by the supplier, a selection from the first consumer indicating desired usage rights and meta-rights; and

generating, by the supplier, a first license granting to the first consumer the usage rights and meta-rights for the items,

wherein the first license grants the usage rights and meta-rights that are selected by the first consumer during the receiving step.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Downs	US 6,226,618 B1	May 1, 2001
Hitson	US 2002/0010759 A1	Jan. 24, 2002

The following rejections are before us for review:

1. Claims 1-13, 15-18, and 29-40 are rejected under 35 U.S.C. §102(b) as being anticipated by Downs.
2. Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Downs.
3. Claim 19 is rejected under 35 U.S.C. §103(a) as being unpatentable over Downs and Hitson.

ISSUE

The issue is whether Downs describes, expressly or inherently, "meta-rights" as claimed.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v.*

Quigg, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. All the claims call for "meta-rights."
2. The Specification provides an express definition for "meta-rights":

> Rights can specify transfer rights, such as distribution rights, and can permit granting of rights to others or the derivation of rights. Such rights are referred to as "meta-rights". Meta-rights are the rights that one has to manipulate, modify, or otherwise derive other meta-rights or usage rights. Meta-rights can be thought of as usage rights to usage rights. Meta-rights can include rights to offer, grant, obtain, transfer, delegate, track, surrender, exchange, and revoke usage rights to/from others. Meta-rights can include the rights to modify any of the conditions associated with other rights. For example, a meta-right may be the right to extend or reduce the scope of a particular right. A meta-right may also be the right to extend or reduce the validation period of a right.

   Specification [0030] (p. 9).
3. The Examiner defines "meta-rights" to mean "Sub-rights, or additional usage conditions derived from the usage rights." Answer 8.
4. According to the Examiner, Downs describes "meta-rights" at col. 9, lines 33-35 and col. 10, ll. 15-18. Answer 3.
5. Col. 9, ll. 33-35, of Downs discloses: "The Metadata Assimilation and Entry Tool 161 is also used to enter the Usage Conditions for the Content 113. The data in Usage Conditions can include copy restriction rules, the wholesale price, and any business rules deemed necessary."
6. Col. 10, ll. 15-18, of Downs discloses: "The secondary usage conditions data can include retail business offers such as Content 113

purchase price, pay-per-listen price, copy authorization and target device types, or timed-availability restrictions."

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

The rejection of claims 1-13, 15-18, and 29-40 under 35 U.S.C. §102(b) as being anticipated by Downs.

It was proper that the Examiner first attempted to construe the claims before reaching a determination as to whether Downs anticipated the claimed subject matter. *Cf. In re Crish*, 393 F.3d 1253, 1256 (Fed. Cir. 2004): "A determination that a claim is anticipated, under 35 U.S.C. § 102(b) involves two analytical steps. First, the Board must interpret the claim language, where necessary. Because the PTO is entitled to give claims their broadest reasonable interpretation, our review of the Board's claim construction is limited to determining whether it was reasonable. *In re*

Morris, 127 F.3d 1048, 1055 (Fed. Cir. 1997). Secondly, the Board must compare the construed claim to a prior art reference and make factual findings that "each and every limitation is found either expressly or inherently in [that] single prior art reference." *Celeritas Techs. Ltd. v. Rockwell Int'l Corp.,* 150 F.3d 1354, 1360 (Fed. Cir. 1998)." FF 3.

However, "claims are to be read in the light [of the specification], not in a vacuum." *In re Dean*, 291 F.2d 947, 951 (CCPA 1961). The written description is "always highly relevant" in construing a claim, and "the speicification … is the single best guide to the meaning of a disputed term." *Vitronics Corp. v. Conceptronic, Inc.,* 90 F.3d 1576, 1582 (Fed. Cir. 1996).

Here the Specification provides an express definition of "meta-rights". FF 2. The definition for "meta-rights" given in the Specification governs the construction to be given that term in the claims.

> [O]ur cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs. *See CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). In other cases, the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor's intention, as expressed in the specification, is regarded as dispositive. *See SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys.*, Inc., 242 F.3d 1337, 1343-44 (Fed. Cir. 2001).

Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005).

The Examiner did not rely on the definition for "meta-rights" expressly provided in the Specification but construed the term in a manner that would cover information about conditions set forth in "metadata" like

those described in Downs. FF 5 - 6. However, information about conditions set forth in "metadata" is not the same as "meta-rights" as the Appellants have defined them - which are "the rights that one has to manipulate, modify, or otherwise derive other meta-rights or usage rights." FF 2. We do not find the information about conditions set forth in "metadata" that Downs discloses to be the same as the "meta-rights" as claimed. Accordingly, we find that a prima facie case of anticipation of the claimed subject matter over Downs has not been established.

The rejection of claim 14 under 35 U.S.C. §103(a) as being unpatentable over Downs.
and
The rejection of claim 19 under 35 U.S.C. §103(a) as being unpatentable over Downs and Hitson.

Claims 14 and 19 depend on claim 15 whose rejection under § 102 is reversed. *See supra*. The rationale in support of the rejections of these claims relies on a construction of the claim term "meta-rights" which is inconsistent with the definition of that term as expressly provided for in the Specification. Answer 6-7. See FF 2. Since the claims have not been given the broadest reasonable construction *in light of the Specification*, a prima facie case of obviousness of the *claimed* subject matter has not been established.

CONCLUSIONS

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 1-13, 15-18, and 29-40 under 35 U.S.C. §102(b) as being anticipated by Downs; claim 14 under 35 U.S.C. §103(a) as being

unpatentable over Downs; and, claim 19 is rejected under 35 U.S.C. §103(a) as being unpatentable over Downs and Hitson.

DECISION

The decision of the Examiner to reject claims 1-19 and 29-40 is reversed.

REVERSED

mev

NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON DC 20004-2128